

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

Claims 1 – 15 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,706,673. In response, Applicants respectfully request that this issue be held in abeyance until allowable subject matter is indicated, at which time Applicants will take appropriate action, for example, by proving patentable distinctness or filing a suitable terminal disclaimer.

Claims 1 – 15 were rejected under 35 USC § 103(a) as being obvious over Klueppel et al. (“Klueppel”), U.S. Patent No. 5,145,665.

Claims 1 – 15 were also rejected under 35 USC § 103(a) as being obvious over Giret et al. (“Giret”), U.S. Patent No. 5,409,640.

In response to *both* prior art rejections, Applicants again respectfully submit that the Examiner has not made out a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw both rejections.

Applicants previously cited *In re Baird*, 29 USPQ2d 1550 (Fed. Cir. 1994), for the proposition that there must be motivation in either Klueppel or Giret to combine the particular ingredients required by the instant claims. In response, the Examiner has taken the position that “*Baird* is not on point in the present case, as it presented a formula which was generic to tens of

thousands of species. Here, there is no generic formula, and the number of possibilities is not particularly vast.”

Applicants respectfully disagree on all counts. The fact that *Baird* involved a generic formula is completely irrelevant. Whether the applicant therein set forth a particular formula embracing tens of thousands of species or set forth generic language amounting to the same thing should make no difference. The Examiner has not explained why the cited reference disclosures, which the Examiner says are “not particularly vast,” teach persons skilled in the art any more than would a structural formula embracing the same subject matter. Respectfully, the distinction on the ground that *Baird* teaches a generic formula is not compelling.

Indeed, Applicants submit that this is a classic genus-subgenus situation, which is, therefore, covered by the procedure outlined in MPEP § 2144.08 (“These [guidelines are for] the examination of applications which contain claims to species or *a subgenus* *** based upon a *single* prior art reference which discloses a genus encompassing the claimed species or subgenus but does not expressly disclose the particular claimed species or subgenus.”) This is exactly the situation involved here. The instant claims are drawn to preparations (a subgenus) that the Examiner says are completely within either Klueppel or Giret (genuses), and this is made clear with the proper selections within Klueppel’s or Giret’s disclosures. The issue of obviousness then boils down to whether there is anything in Klueppel or Giret that would have motivated persons skilled in the art to make all of the selections in Klueppel or Giret that would have been necessary for persons skilled in the art to make the instantly claimed preparations.

The Examiner basically says the instant preparations are within the prior art, therefore, they are obvious. Again, Applicants respectfully disagree. The *Baird* is cited in MPEP §2144.08 in support of the following proposition:

“The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness.”

Thus, the MPEP does not attempt to distinguish *Baird* on the ground that a structural formula was involved, nor should the Examiner. Instead, *Baird* is cited in support of a general proposition that simply because a narrower claimed invention is within the teachings of a broader prior art disclosure is not sufficient, in and of itself, to establish *prima facie* obviousness. More is needed. Applicants respectfully submit such “more” is missing on the current record.

MPEP §2144.08(II)(A)(4)(a) provides:

“Some motivation to select the claimed species or subgenus must be taught by the prior art.”

Applicants submit that this is exactly what is missing here. The Examiner has identified the instantly claimed components within the broad teachings of Klueppel and Giret, *but not any motivation* in most cases to make the particular selections necessary to achieve the claimed preparations. In the absence of such motivation, Applicants submit the Examiner has not made out a *prima facie* case of obviousness.

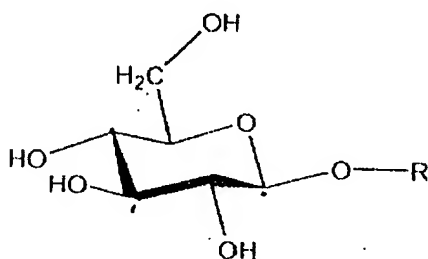
The Examiner says “the number of possibilities is not *particularly* vast.” Again, Applicants respectfully disagree. The number of possible preparations within Klueppel’s or Giret’s disclosures are not only vast, they are staggering. And, the instantly claimed subgenus represents only a microscopic portion of those species. Applicants submit that without improper benefit of Applicants’ disclosure, there is absolutely no reason that a person of ordinary skill in

the art, given only Klueppel or Giret, would have been led to the instantly claimed preparations. Accordingly, the instant claims are, in fact, nonobvious over both Klueppel and Giret.

Instant claim 1 is reproduced below:

1. Cosmetic and dermatological deterative preparations comprising:

- (a) an amount of one or more surface-active substances selected from the group consisting of alkyl glucosides, which have the structural formula:



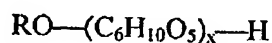
where R is a branched or unbranched alkyl radical having from 1 to 24 carbon atoms,

- (b) an amount of one or more gel-forming acrylate-alkyl acrylate copolymers, and
- (c) an amount of one or more branched and/or unbranched aliphatic alcohols having 2 - 6 carbon atoms and one or more OH functions.

Klueppel

Klueppel's disclosure relates generally to oral and dental care preparations that contain, as the essential components:

- A) polysaccharide-splitting enzymes, especially dextranase; and
- B) alkylglycosides, preferably those corresponding to the formula:



where R is a primary C₈₋₂₂ fatty alcohol residue, and X is 1-10, preferably 1-3.

The crucial ingredient is Klueppel's ingredient B). A comparison of Klueppel's formula and Applicants' alkyl glucoside formula in claim 1(a), indicates the two formulas are not identical. Klueppel's formula is generic to Applicants' formula in claim 1(a). Although Klueppel states that x is preferably 1-3, this allows three possibilities. Moreover, Klueppel does not claim a particular molecular arrangement of the C₆H₁₀O₅ grouping, so this embraces many isomers. Considering that X may be 1-3 and the large number of isomeric possibilities for C₆H₁₀O₅, Applicants submit that Klueppel does not teach Applicants' alkyl glucosides specifically, but, rather, only generically, and that, given Klueppel, a person having ordinary skill in the art needed to make a selection of Applicants' specific alkyl glucosides from among Klueppel's generic alkyl glycosides.

Klueppel next teaches at column 2, lines 62-66 that:

"In addition to the characteristic, polysaccharides splitting enzymes and the alkylglycosides, the oral and dental care preparations

according to the invention contains the aqueous carriers typical of the particular formulation.”

According to the Examiner, Applicants’ ingredients 1(b) and 1(c) are humectants. Actually, Applicants’ 1(b) would be Klueppel’s viscosity regulators, and 1(c) would be Klueppel’s humectants. At column 2, line 67, through column 3, line 8, Klueppel sets forth the ingredients for mouthwashes. These do not contain either humectants or viscosity regulators. At column 3, lines 9-19, Klueppel sets for the ingredients for toothpastes or tooth creams, and these do contain as possibilities humectants and/or viscosity regulators, out of about 10 listed possible ingredients.

Next, among the humectants, Klueppel lists glycerol as one of thousands of possible ingredients (the propylene glycols and polyethylene glycols in the list literally embrace thousands of possible species.)

And, among the viscosity regulators, Klueppel lists Carbopol® type polymers, again, as one of thousands of possible ingredients, including starches, starch ethers, cellulose ethers, pectins, polyethylene glycols having molecular weights of 1,500 to 1,000,000, thereby reading on literally millions of species.

Accordingly, in order for a person having ordinary skill in the art to arrive at the preparations of the instant claims, one of ordinary skill in the art must:

- 1) Choose Applicants’ specific alkyl glucosides from Klueppel’s generic alkyl glucosides (a selection of one out of tens of possibilities);
- 2) Choose a toothpaste or tooth cream as opposed to a mouthwash or other dental preparation (a selection of one of a few);

- 3) Choose to include both humectants and viscosity regulations in the preparation (a selection of two out of about 10 or so possibilities);
- 4) Choose glycerol from thousands of possibilities; and
- 5) Choose Carbopols® from millions of possibilities.

Other than glycerol, which is used in the tooth cream formulation of Klueppel's example 2, there is nothing in Klueppel to highlight the other selections necessary to achieve Applicants' claimed invention. Klueppel does mention "alkyl glucoside" in his examples, but this is still generic to Applicants' specific alkyl glucoside in claim 1(a). More importantly, there is nothing to highlight Carbopols® or to suggest their selection and inclusion along with glycerol and Applicants' specific alkyl glycosides into a single preparation. Thus, Applicants preparations, as a whole, remain a small group out of literally millions of possible preparations falling under Klueppel's disclosure—even with Klueppel's disclosure being focused to glycerol and "alkyl glucosides"!

Respectfully, Klueppel is not sufficiently focused enough to make out a *prima facie* case of the obviousness of the instant claims. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the rejection based on Klueppel.

Giret

The disclosure of Giret is even more ambiguous than Klueppel's. Disclosed is a personal cleansing product comprising:

- (a) anionic surfactant;
- (b) amphoteric surfactant;
- (c) vegetable oil adduct; and
- (d) water.

However, none of these ingredients are at issue. Apparently, the obviousness issue centers on *optional* ingredients to be added to these main ingredients.

Thus, Giret teaches at column 5, lines 53-56, that the preparation "preferably" (not mandatory) contains a nonionic surfactant. Giret then gives a list of polysaccharides that includes literally tens of millions of species. Never mind that the species of instant claim 1(a) is a monomer, Giret teaches at column 6, lines 42-45, that there may be a content of "alkylmonosaccharide." The disclosure is not believed to get closer to Applicants' specific alkyl glucoside than that, yet this generic teaching still embraces hundreds, if not thousands of species, of which Applicants' specific alkyl glucosides are but one.

Giret also teaches at column 7, lines 33-37, that the preparation may contain a cationic or nonionic polymeric skin or hair condition agent. Giret further teaches at column 7, lines 46-47, that the useful polymers include cationic, nonionic, amphoteric, and anionic polymers – basically

any polymer. As examples of suitable anionic polymers, Carbopols® are also mentioned, but, again, there is nothing to highlight anionic polymers among the useful polymers, or Carbopol® among the useful anionic polymers.

Then, Giret teaches at column 8, lines 32-33, that the preparation can optionally include a moisturizer. Glycerine is mentioned as preferred, but as an optional ingredient. Thus, of the seven examples given at column 10, glycerine appears in only one, and Carbopol® does not appear to be present in any.

Thus, in order to achieve the present invention, given Giret, a person skilled in the art must:

- (1) Choose to include a nonionic surfactant (one of two possibilities);
- (2) Choose to include as the nonionic surfactant Applicants' claim 1(a) alkyl glucoside as Giret's alkyl monosaccharide (one of hundreds of thousands of possibilities);
- (3) Choose to include a polymeric skin or hair conditioning agent (one of two possibilities);
- (4) Choose to include an anionic polymer as said hair conditioning agent (one of four possibilities);
- (5) Choose Carbopols® as the anionic polymer (one of thousands of possibilities);
- (6) Choose to include a moisturizer (one of two possibilities); and

- (7) Choose glycerine as the moisturizer (one of many possibilities, but glycerine is highlighted).

Respectfully, other than the selection of glycerine, which even then is expressly taught by Giret to be optional, there is nothing in Giret to lead persons skilled in the art to the remaining selections necessary to achieve the claimed invention.

Again, simply because in hindsight the instant preparations can be located within Giret's broad generic teachings is not enough alone to establish obviousness. Rather, Giret must also provide some motivation that would have led persons skilled in the art to make the specific selections necessary to achieve the claimed invention. Such motivation is not evident on this record. The Examiner has only explained where in Giret's teachings each of Applicants' claimed ingredients can be found. What the Examiner has not done is to explain how the reference would have motivated persons skilled in the art to select Applicants' particular ingredients from among the many recited and then to combine all the selected ingredients together to achieve the present claims. Absent that explanation, the Examiner has not made out a *prima facie* case of obviousness.

In view of the foregoing, Applicants submit that the Examiner should reconsider and withdraw the rejection based on Giret as well. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

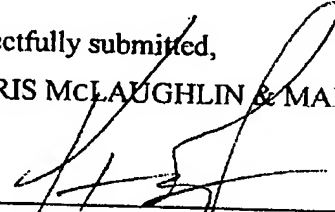
Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to

telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
NORRIS MCLAUGHLIN & MARCUS, P.A.

By



Kurt G. Briscoe
Attorney for Applicant(s)
Reg. No. 33,141
875 Third Avenue - 18th Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844